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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,874	10/12/2006	Thomas Nissl	NISSL-3	5933
20151 7590 11/19/2009 HENRY M FEIEREISEN, LLC HENRY M FEIEREISEN 708 THIRD AVENUE SUITE 1501 NEW YORK, NY 10017				
EXAMINER				
BONK, TERESA				
ART UNIT		PAPER NUMBER		
3725				
NOTIFICATION DATE		DELIVERY MODE		
11/19/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

INFO@FEIEREISENLLC.COM

# Office Action Summary

**Application No.**

10/599,874

**Applicant(s)**

NISSL, THOMAS

**Examiner**

Teresa M. Bonk

**Art Unit**

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,8-10,13-17 and 20-22 is/are rejected.
- 7) ☒ Claim(s) 2,6,7,11,12,18 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date \_\_\_\_
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on October 12, 2006 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Drawings***

The drawings are objected to because the character of the lines and numbers, including lead lines are not well-defined, in order to give them satisfactory reproduction characteristics (especially Figure 1 which appears to be a copy of a photograph).

See MPEP 37 CFR 1.84 Standards for drawings. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR

1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9 and 21-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regards to claims 9 and 21, there is insufficient antecedent basis for “the form.”

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, 5, 10, 13-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Duffield et al. (hereafter “Duffield”) (US Patent 3,568,495).

With regards to claim 1, Duffield discloses an apparatus, comprising radially inwardly moving segmental compressors (30) which act, at least indirectly, radially on an outer surface of a workpiece and are supported on a circumferential abutment (25), flexible tensioning members

(10) provided between the compressors and the abutment, as seen in Figure 2, and actuable by a pressure fluid [Column 2, lines 65+ - Column 3, lines 1-15] in opposition to a resiliently elastic rebound force (springs 16).

It is noted that with regards to claims 1 and 10 the limitation “for reducing the diameter of stent” is a recitation of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). Duffield is considered to be capable of performing the intended use.

With regards to claim 3, Duffield discloses wherein the compressors have concave contact surfaces (groove arrangement 31) in a direction towards the circumferential abutment, and wherein the abutment has concavely curved resistance surfaces, which are open towards a center axis of the abutment for the tensioning members, as seen in Figure 2.

With regards to claim 4, Duffield discloses wherein the compressors are disposed in at least two parallel planes and radially movable in each plane independently of compressors of a neighboring plane, as seen in Figure 2.

With regards to claim 5, Duffield discloses wherein the abutment extends across all planes, as seen in Figure 2.

With regards to claim 10, Duffield discloses an apparatus comprising: a compressor (30) constructed to move radially inwardly to act, at least indirectly, radially upon an outer surface of a workpiece; an abutment (25) for support of the compressor; a resiliently elastic rebound

mechanism (16); and a flexible tensioning member (10) arranged between the abutment and the compressor and rendered operative by pressure fluid in opposition to a force applied by the rebound mechanism [Column 2, lines 65+ - Column 3, lines 1-15].

With regards to claim 13, Duffield discloses wherein the abutment is defined by a center axis, the compressor having a concave contact surface (groove arrangement 31) in a direction towards the abutment and the abutment having a complementary concavely curved resistance surface, which is open towards the center axis, to define a space for receiving the tensioning member, as seen in Figure 2.

With regards to claim 14, Duffield discloses further comprising a plurality of said compressor disposed in parallel planes, wherein compressors in one plane are movable in radial direction independently of compressors in a neighboring plane, as seen in Figure 2.

With regards to claim 15, Duffield discloses wherein the compressors are positioned about a circle, with the abutment disposed in surrounding relationship to the compressors, as seen in Figure 2.

With regards to claim 16, Duffield discloses wherein the abutment is sized to extend across all the planes, as seen in Figure 2.

With regards to claim 17, Duffield discloses wherein the abutment has a cylindrical configuration, as seen in Figure 2.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duffield in view of Kokish (Pub. No. US 2003/0070469).

Duffield discloses wherein the abutment is made of a metal [Column 5, line 4]. Duffield discloses the invention substantially as claimed except for wherein the compressors are made of plastic. Kokish is relied upon to teach that stent crimping assemblies may be formed of plastic and metal parts including a combination of both [Paragraph 0057]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the compressors made of plastic since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of mechanical efficiency.

***Allowable Subject Matter***

Claims 2, 6, 7, 11, 12, 18, and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 9 and 21-22 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teresa M. Bonk whose telephone number is (571)272-1901. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on 571-272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Teresa M. Bonk/  
Examiner, Art Unit 3725